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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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PATTON BOGGS LLP
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WASHINGTON, DC 20037

EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,039

Applicant(s)

CAUGHEY ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because this application has been filed with informal drawings which are acceptable for examination purposes only. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (US 6,014,644) in view of Bergman et al. (US 2002/0038259 A1) hereafter referred to as Bergman and further in view of Official Notice.

Referring to claim 1: Erickson a method for posting offerings for goods and services and for receiving responses, comprising:

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- receiving a plurality of offer data records at a database, from one or more seller computers remote from said database, each having a descriptor data field identifying a commodity and an identify of an offeror (col. 3, lines 13-42; Figure 1, items "12" and "16"; col. 7, lines 18-34, lines 44-67);
- storing said plurality of offer data records into said database (col.3, lines 31-42);
- receiving at said database an inquiry from a buyer computer remote from said database, said inquiry having a search field corresponding to at least a portion of said descriptor data field (col. 3, lines 43-51; col. 8, lines 28-31);
- selecting one or more of said offer data records from said database based on said search field (col. 3, lines 43-51: "...assemble a list of suppliers...");
- receiving at said database a purchase order data record from said buyer computer (col. 13, lines 49-60);
- storing said purchase order data record in said database (col. 4, lines 38-40; col. 13, lines 30-60). Erickson teaches that the purchase order is stored in a data cast message (col. 13, lines 30-60), and that the data cast message is later stored in a database (col. 4, lines 38-40);
- transmitting a purchase order received data to the offeror identified by the descriptor field of said particular offer data record (col. 4, lines 22-29). Erickson teaches that the purchase order is stored in a data cast message (col. 13, lines 30-60), and that the data cast message is sent to a supplier (i.e. offeror) (col. 4, lines 22-29);

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- receiving at said database a seller response data from said offeror, said seller response data having an acceptance field reflecting acceptance of, rejection of, or a counter-offer to said one or more terms of an offer for purchase (col. 4, line 38 – col. 5, line 33; col. 16, line 66- col. 17, line 9);
- storing said seller response data in said database (col. 4, lines 38-40; col. 4, line 56 – col. 5, line 11);
- transmitting to said buyer a seller response received data (col. 4, lines 56-67; col. 16, line 66 – col. 17, line 5).

Erickson does not teach that his method is for negotiating responses. However, the Examiner notes that this limitation only appears in the preamble of the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present case, the body of the claim does not depend on the preamble for completeness because there is no “negotiating” taking place. Thus the limitations in the body are able to stand alone and independently of the “negotiating” limitation in the preamble. Erickson does not explicitly state transmitting the data record to the buyer computer. However, this limitation is inherent in the disclosure of Erickson because Erickson teaches that the buyer accesses records in a central database via key word (col. 3, lines 43-51; col. 7, lines 7-18) in order to assemble a list of suppliers

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(col. 3, lines 49-51). Therefore, if the records from the database are not transmitted to the buyer computer then the buyer will not be able to assemble the list of suppliers. Erickson does not teach initializing to a first state a status flag data associated with each of said plurality of offer data records or changing to a second state the status flag data associated with said particular offer data record. However, Bergman discloses a method of ordering goods via a mobile device wherein the orders are initialized to a first state by setting the status to "pending" and then changing the status to a second state when the order is fulfilled (paragraph [0051]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the status change feature of Bergman into the method of Erickson. One of ordinary skill in the art would have been motivated to do so in order to allow the buyer or seller to know the current status their offer. The cited prior art does not teach that the purchase order data record identifies a buyer and a particular offer data record from said one or more selected offer data records, and has a purchase offer field identifying one or more terms of an offer for purchase of the commodity identified by the descriptor field of said particular offer data record. However, Official Notice is taken that it is old and well known in the art for a purchase order to identify a buyer, a particular offer, and one or more terms of the offer. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this information into the purchase order of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to create a legal document identifying the various parties, products, and terms of a commercial transaction. The cited prior art does not explicitly

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disclose the step of receiving at said database a committed purchase order data from said buyer. However, Erickson teaches that once the buyer receives the suppliers' information, the buyer then performs an analysis of the information "...in order to make a sound purchasing decision." (col. 20, line 63 – col. 21, line 1). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a committed purchase order in the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow the buyer to execute a purchasing transaction once the analysis was complete, as suggested by Erickson. The cited prior art does not teach that the seller response received data identifies contents of the acceptance field of said seller response data. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what information the seller response data identified. The differences between the Applicants' invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the data cast message response of Erickson because such information does not functionally relate to the steps of the claimed method and

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because the subjective interpretation of information does not patentably distinguish the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
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September 26, 2005